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Anjali Abhimanyu Patil

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EXAMINER

ROGERS, JAMES WILLIAM

ART UNIT

PAPER NUMBER

1618

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/637,459 | <b>Applicant(s)</b><br>PATIL ET AL. |  |
|                              | <b>Examiner</b><br>JAMES W. ROGERS   | <b>Art Unit</b><br>1618             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-18,20-26 and 28-40 is/are pending in the application.
- 4a) Of the above claim(s) 3,5,6,8-11,13-18,20-22,24,25 and 28-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2,4,12,23 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The amendments to the claims filed 05/15/2008 have been entered. Applicants have cancelled claims 7 and 19 and amended claims 1 and 26. Any rejection from the previous office action filed 05/23/2007 not addressed in the action below has been withdrawn.

### ***Response to Arguments***

Applicant's arguments with respect to the claims previously rejection in the office action filed 05/23/2007 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2,12 and 26 rejected under 35 U.S.C. 102(e) as being anticipated by Yu (US 2003/0235552 A1), this new rejection was necessitated by applicants amendment to the claims.

Yu teaches a cosmetic composition containing a liquid fatty phase that can comprise just a linear volatile siloxane such as decamethyltetrasiloxane (DMTS) and polydimethylsiloxane (PDMS) a structuring polymer that is a polyorganosiloxane and at

Art Unit: 1618

least one film forming silicone resin. See abstract,[0027]-[0032],[0040]-[0043], table 1, [0070], [0108]-[00113],[0299]-[0360] and claims 1-2 and 6. Since applicants define within their specification that the film forming polymer is a siloxane polymer or copolymer the examiner considers the structuring polymer of Yu to satisfy the limitation of a film-forming polymer, since more than one film-forming polymer may be present applicants' claims do not preclude the structuring polymer and film forming polymers in combination as taught by Yu.

Claims 1,2,4 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Auguste (US 2004/0197284 A1), this new rejection was necessitated by applicants amendment to the claims.

Auguste teaches a cosmetic composition comprising a volatile silicone fatty phase comprising at least one non-cyclic volatile silicone including octamethyl-trisiloxane, the composition can further include additional ingredient(s) including a polymer film former. See abstract, [0019],[0039]-[0075], claims, especially claims 1,10,28 and 88.

Claims 1-2,12,23 and 26 rejected under 35 U.S.C. 102(e) as being anticipated by Patil et al. (US 2004/0156806 A1), this new rejection was necessitated by applicants amendment to the claims.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Patil teaches a cosmetic composition containing at least one siloxane film forming resins (including siloxane-acrylate copolymers) in a pharmaceutically acceptable carrier such as hexamethyldisiloxane. See [0016]-[0052], [0151]-0217] and claims, especially claims 1 and 18-20.

Claims 1-2,12,23 and 26 rejected under 35 U.S.C. 102(e) as being anticipated by Manelski et al. (US 2004/0180032 A1), this new rejection was necessitated by applicants amendment to the claims.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Manelski teaches a long wearing cosmetic composition comprising at least one silicone polyamide (described as a film former) solvated in a pharmaceutically acceptable carrier that included hexamethyldisiloxane. See abstract, [0040]-[0049],[0086] and claims 1,4-6 and 8. Manelski also teaches the use of additional film-forming polymers besides the silicone polyamide including silicone acrylate copolymers. See [0091]-[0017].

***Claim Rejections - 35 USC § 103***

Art Unit: 1618

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2,4,12,23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patil et al. (US 2004/0156806 A1) or alternatively Manelski et al. (US 2004/0180032 A1) both of the above in view of Auguste (US 2004/0197284 A1), this new rejection was necessitated by applicants amendment to the claims.

Patil and Manelski are disclosed above. While both references describe the use of volatile linear siloxanes in the representative cosmetic formulations the two references are silent on the specific volatile linear siloxane octamethyltrisiloxane required within dependent claim 4.

Auguste is disclosed above and is used primarily for the disclosure within that the specific volatile linear siloxane octamethyltrisiloxane was already well known to be useful as a solvent in cosmetic formulations at the time of applicant's claimed invention.

It would have been prime facie obvious at the time of the invention to a person of ordinary skill in the art to modify the volatile linear siloxane solvents disclosed in Patil and Manelski and add the specific volatile linear siloxane octamethyltrisiloxane disclosed within Auguste. It is generally considered to be prime facie obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. The motivation for combining them flows from their having been used individually in the prior art, and from them being recognized in the prior art as useful for the same purpose. As shown by the recited teachings, instant claims are no more than the combination of conventional components of a cosmetic formulation. It therefore follows that the instant claims define prime facie obvious subject matter.

Claims 1-2,4,12,23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu (US 2003/0235552 A1) in view of Patil et al. (US 2004/0156806 A1) in view of Patil (6,342,209 B1, cited previously), this new rejection was necessitated by applicants amendment to the claims.

Yu is disclosed above. While Yu describes the use of volatile linear siloxanes in the representative cosmetic formulations the references is silent on the specific volatile linear siloxane octamethyltrisiloxane required within dependent claim 4. Furthermore while Yu discloses the use of silicone resin film formers the reference is silent on the use of a silicone-acrylate copolymer as required in dependent claim 23.

Auguste is disclosed above and is used primarily for the disclosure within that the specific volatile linear siloxane octamethyltrisiloxane was already well known to be useful as a solvent in cosmetic formulations at the time of applicants claimed invention. It would have been prime facie obvious at the time of the invention to a person of ordinary skill in the art to modify the volatile linear siloxane solvents disclosed Yu and add the specific volatile linear siloxane octamethyltrisiloxane disclosed within Auguste. It is generally considered to be prime facie obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. The motivation for combining them flows from their having been used individually in the prior art, and from them being recognized in the prior art as useful for the same purpose. As shown by the recited teachings, instant claims are no more than the combination of conventional components of a cosmetic formulation. It therefore follows that the instant claims define prime facie obvious subject matter.

Patil is used primarily for the disclosure within that silicone acrylate film-formers were already well known at the time of applicants claimed invention to be useful within cosmetic formulations. See abstract and col 3 lin 28-41. It would have been prime facie



Art Unit: 1618

obvious at the time of the invention to a person of ordinary skill in the art to modify the siloxane film forming resins disclosed in Yu and add the specific silicone-acrylate resin disclosed within Patil. It is generally considered to be prime facie obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. The motivation for combining them flows from their having been used individually in the prior art, and from them being recognized in the prior art as useful for the same purpose. As shown by the recited teachings, instant claims are no more than the combination of conventional components of cosmetic formulations. It therefore follows that the instant claims define prime facie obvious subject matter.

### ***Conclusion***

No claims are allowed at this time.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1618

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 271-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael G. Hartley/

Supervisory Patent Examiner, Art Unit 1618